

## **REMARKS**

### **A. Status of the Claims**

Claims 1-19 were pending in the case at the time of the Action and are currently under consideration.

### **B. The Rejection Under 35 U.S.C. §103 Is Overcome**

Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Martinell *et al.* (U.S. Patent 6,384,301) and Trolinder *et al.* (U.S. Patent 5,994,624) in view of Jefferson *et al.* (*The EMBO J.*, vol. 6(13), 3901-3907 (1987)). Applicants respectfully traverse.

#### **1. Martinell *et al.* is Commonly Owned and Thus in Not Prior Art Under 35 U.S.C. §103(c)**

Applicants initially note that the Martinell *et al.* patent was assigned to “Monsanto” as shown at Reel/Frame 010510/0535, and later assigned to Monsanto Technology LLC, as shown at Reel/Frame 012350/0224. **Exhibit A.** The current case is also assigned to Monsanto Technology LLC as evidenced at Reel/Frame 012472/0490. **Exhibit B.** “Monsanto” refers to Monsanto Company, which is the parent company of wholly owned subsidiary Monsanto Technology LLC. The Martinell *et al.* patent and the current case were therefore commonly owned and/or subject to a common duty to assign to Monsanto Company at the time the invention was made.

Applicants note that the Martinell *et al.* patent is prior art only under 35 U.S.C. §102(e) (see May 4, 2006 Office Action). Pursuant to 35 U.S.C. § 103(c), subject matter that is developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention

were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As both the Martinell *et al.* patent and the current case were subject to a common obligation of assignment to Monsanto Company and/or common ownership as of the priority date, the Martinell *et al.* patent may not be applied as prior art against the current case. Therefore, because the entire rejection is premised on the Martinell *et al.* patent, withdrawal of the rejection is thus respectfully requested.

## **2. The Cited Art Does Not Teach All Elements of the Claims**

Claims 1-19 are additionally not obvious, at least, because the prior art fails to teach or suggest all limitations of the claims. Applicants initially note in this regard that the term “piece” is not recited in current claim 1, and therefore the Action’s comments regarding this term are moot.

With regard to the claim limitations, although the Action states that Martinell *et al.* teach the element of “(e) identifying roots that assay positive for said at least one nucleic acid sequence as putative germline transgenic plants,” in fact, Martinell *et al.* does not teach this. The roots that assay positive in step (e) are roots whose tissue extracts are subject to assaying in step (d). The Action acknowledges that Martinell *et al.* “do not teach obtaining a piece of root tissue or extract thereof from the transformed plant tissue, [or] assaying the extract thereof for the presence of the nucleic acid.” Because Martinell *et al.* does not teach the assay of step (d) involving root extracts, the reference cannot teach or suggest the identification of roots that are positive by such assay, even if the reference is assumed to be properly cited as prior art, which it is not as set forth above. Accordingly, Martinell *et al.* does not teach or suggest step (e) of claim 1.

In a similar manner, Martinell *et al.* does not teach or suggest the corresponding step (g) of claim 16.

The other references do not remedy the defects in the Martinell *et al.* reference. Trolinder *et al.* does not mention assaying root extracts for the presence of nucleic acids, and therefore does not teach or suggest identifying roots that assay positive.

As for Jefferson *et al.*, although this reference describes assaying roots for the presence of transformed gene constructs, nothing in Jefferson *et al.* teaches or suggests that root extracts are indicative of putative germline transformation. Rather, Jefferson *et al.* deals with the development of GUS fusion genes for use as markers in plants. The use of root extracts was simply to show the expression of the fusion genes in various plant tissues, and had nothing to do with identifying putative germline transformants. Jefferson *et al.* does not involve identifying putative germ line transformants and therefore does not teach or suggest step (e) of claim 1.

In sum, the prior art fails to teach all limitations of the claims. As such, claims 1-19 are not obvious. Withdrawal of the rejection of claims 1-19 under 35 U.S.C. §103(a) is therefore respectfully requested.

#### **C. Obviousness-Type Double Patenting Rejection**

In regard to the obviousness-type double patenting rejection, Applicants respectfully traverse but note that a Terminal Disclaimer will be submitted upon the allowability of the case. The rejection is therefore believed moot and removal thereof is thus respectfully requested.

#### **D. Conclusion**

In view of the foregoing, it is respectfully submitted that each of the pending claims is in condition for allowance, and a Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned attorney at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date: May 29, 2007

## **EXHIBIT A**



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## Patent Assignment Abstract of Title

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## Total Assignments: 2

**Patent #:** 6384301      **Issue Dt:** 05/07/2002      **Application #:** 09483472      **Filing Dt:** 01/14/2000**Inventors:** Brian J Martinell, Lori S Julson, Carol A Emler, Yong Huang, Dennis E McCabe et al**Title:** Soybean Agrobacterium Transformation Method

## Assignment: 1

**Reel/Frame:** 010510/0535**Recorded:** 01/14/2000**Pages:** 7**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignors:** MARTINELL, BRIAN J.**Exec Dt:** 01/07/2000

JULSON, LORI S.

**Exec Dt:** 01/07/2000

EMLER, CAROL A.

**Exec Dt:** 01/07/2000

HUANG, YONG

**Exec Dt:** 01/07/2000

MCCABE, DENNIS E.

**Exec Dt:** 01/07/2000

WILLIAMS, EDWARD J.

**Exec Dt:** 01/07/2000**Assignee:** MONSANTO700 CHESTERFIELD PARKWAY NORTH  
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## Assignment: 2

**Reel/Frame:** 012350/0224**Recorded:** 06/13/2001**Pages:** 54**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignor:** PHARMACIA CORPORATION, FORMERLY KNOWN AS  
MONSANTO COMPANY**Exec Dt:** 06/11/2001**Assignee:** MONSANTO TECHNOLOGY LLC800 NORTH LINDBERGH BOULEVARD  
ST. LOUIS, MISSOURI 63167**Correspondent:** MONSANTO COMPANYGAIL WUELLNER - MAIL ZONE E2NA  
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## Assignments on the Web &gt; Patent Query

## Patent Assignment Abstract of Title

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## Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 09683399

Filing Dt: 12/21/2001

Publication #: US20020123045

Pub Dt: 09/05/2002

Inventors: Brian J. Martinell, Lori S. Julson, Carol A. Emler, Venera Bouriakova, Dennis E. McCabe et al

Title: Plant transformation process with selection and early identification of germline events

## Assignment: 1

Reel/Frame: 012472/0490

Recorded: 03/12/2002

Pages: 7

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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